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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,579	11/02/2000	Brian M. Fendly	P1053R1D1	5667

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06/03/2003

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EXAMINER

YAEN, CHRISTOPHER H

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 06/03/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/705,579

Applicant(s)

FENDLY, BRIAN M.

Examiner

Christopher H Yaen

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 42-56,63,65 and 66 is/are pending in the application.
- 4a) Of the above claim(s) 43 and 45-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43,44,55,56,65 and 66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The amendment filed 3/19/2003 (paper no. 10) is acknowledged and entered in the record. Accordingly, claims 59-62, 64, and 67-68 are canceled without prejudice or disclaimer. Claims 43, and 45-54 are withdrawn from further consideration as being drawn to a non-elected invention. Applicant is reminded to cancel claims drawn to non-elected invention(s)

2. Therefore, claims 42, 44, 55-56, 63, 65-66 are examined on the record.

#### ***Claim Rejections Withdrawn - 35 USC § 112, 2<sup>nd</sup> paragraph***

3. The rejection of claims 42, 63, and dependent claims thereof under 35 USC 112, 2<sup>nd</sup> paragraph is withdrawn in view of the amendments to the claims.

4. The rejection of claims 55-56 and 66 under 35 USC 112, 2<sup>nd</sup> paragraph is withdrawn in view of the amendments to the claims.

#### ***Claim Rejections Withdrawn - 35 USC § 112, 1<sup>st</sup> paragraph***

5. The rejection of claims 42, 44, 55-56, 63, and 65-66 under 35 USC 112, 1<sup>st</sup> paragraph as lacking enablement is withdrawn in view of the arguments presented by the applicant.

#### ***Claim Rejections Maintained - 35 USC § 102***

6. The rejection of claims 42, 44, and 63 under 35 USC 102(e) as being anticipated by Hudziak *et al* is maintained for the reasons of record. Applicant argues that the amendment to the claims renders the rejection moot. Applicant's arguments have been carefully considered but are not found persuasive because the method disclosed still utilizes the same products taught by Hudziak *et al*. The disclosure of Hudziak *et al*

Art Unit: 1642

teaches the use of vinca drugs in combination an anti-ErBb2 antibody. Because vinorelbine is also a vinca drug and because not all possible drugs within a class of drugs could be listed, the claimed invention is still anticipated.

### ***New Arguments***

#### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 42,44,55, 63, and 65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,4,22,23 of U.S. Patent No. 5,720,954. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant invention are a method of treating comprising the administration of an anti-erbB2 antibody in conjunction with Vinorelbine, while the claims of the US patent are drawn to a method of treating comprising the administration of a cytotoxic factor, wherein the said factor is a chemotherapeutic agent. It would have been obvious to one of skill in the art to substitute the any chemotherapeutic agent into the claims of the US Patent and

Art Unit: 1642

because Vinorelbine is a vinca drug which was known at the time of filing to be a chemotherapeutic agent, the replacement of one therapeutic agent for another would be obvious.

***Conclusion***

9. No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 703-305-3586. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone

Art Unit: 1642

numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Christopher Yaen  
Art Unit 1642  
May 23, 2003



ANTHONY C. CAPUTA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600